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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,752	11/30/2001	Joachim Hecht	1903	3712

7590 08/26/2003
STRIKER, STRIKER & STENBY
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EXAMINER

DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,752

Applicant(s)

HECHT ET AL.

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) 5,9,10,12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8,11,13,14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Claim 11 is generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claim 11, directed to the species of figure 3 no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim. However, claim 12, directed to the species of figure 6 remain withdrawn from consideration since the species of figure 3 which clearly shows 2 tracks depends upon or otherwise include all the limitations of an allowed generic claim as required by 37 CFR 1.141.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Specification

2. The disclosure is objected to because of the following informalities: in the specification Page 13, Line 6, sensing unit is being referred to as numbers 26 and 56.

Appropriate correction is required.

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1,2 and 5-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1,13 and 14, the word "means" is preceded by the word(s) "drive" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1,2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hecht (US 6,199,640) in view of Shinma (US 5,775,440).

In regard to claim 1, Hecht discloses the invention substantially as claimed including a power tool, comprised of housing 10, drive means 14, striking mechanism 17, drive unit 11, curved tracks 22 and 23, with raised portions 221 and 231, depressed portions 222 and 232, sensing unit 21 and sensing members 40 in communication with the curved tracks (see Figs. 1,3 and C2, L42 – C3, L36). What Hecht does not disclose is the use of a striker mounted outside the drive means. However, Shinma teaches that it is old and well known in the art of power tools provide a striker 31, that is mounted outside of drive means 13 for the purpose of reducing the tool area (see Fig. 1 and C4, L20-24). Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Hecht with the striker arrangement of Shinma for the purpose of reducing the tool area.

In regard to claim 2, Hecht discloses the invention substantially as claimed including the drive means further comprised of beater 18, that is supported axially displaceably, and abuts striker 17.

In regard to claim 11, Hecht discloses the invention substantially as claimed including curved tracks 22 and 23 supported by spring 24.

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8. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hecht in view of Shinma and in further view of Fisher (US 5,427,188).

Hecht and Fisher ('709) disclose the invention substantially as claimed including a sensing unit 21 in contact with curved tracks 22 and 23. What Hecht does not disclose is the use of multiple sensing members. However, Fisher ('188) teaches that it is old and well known in the art to provide a sensing unit 44 comprised of multiple sensing members 44, that is limited in movement in an axial direction by abutment 48, which is fixed on drive means 50 for the purpose of balancing torque and bearing loads on the tool during operation (see Figs. 4 and 5). Therefore, it would have been obvious to one having ordinary skill in the art to have modified the invention of Hecht with the sensing arrangement of Fisher ('188).

Allowable Subject Matter

9. Claims 13 and 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Arguments

10. Applicant's arguments, see page 10, filed 7/11/03, with respect to the rejection(s) of claim(s) 1 under the basis that the teaching of Fischer ('709) does not teach of a striker mounted outside of the drive means have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further

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consideration, a new ground(s) of rejection is made in view of Shinma in that in the broadest interpretation of the claim, Shinma teaches a striker that is mounted outside of the drive means.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 703-305-4962. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Paul Durand
August 20, 2003



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700